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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,953	12/06/2000	Donald Ray Gillis	SJO9-2000-0055US1	1412
7590 08/23/2004			EXAMINER	
Lewis L Nunnelley Hitachi Global Storage Technologies Intellectual Property Law 5600 Cottle Road, NHGB/0142 San Jose, CA 95193			RENNER, CRAIG A	
			ART UNIT	PAPER NUMBER
			2652	
			DATE MAILED: 08/23/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,953

Applicant(s)

GILLIS ET AL.

Examiner

Craig A. Renner

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 9 and 13-34 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 8, 9, 13-31, 33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 13-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to one or more non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 19 November 2002.

2. Claims 2-5, 8-9 and 33-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to one or more non-elected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 24 February 2003.

Drawings

3. The drawings were received on 26 May 2004. These drawings are accepted.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following is suggested:

--SLIDER WITH BURNISHED SURFACE DEFINED BY HELIUM OR NEON
BURNISHING FLUID TO BE PARALLEL WITH HARD DISK SURFACE--.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cunningham (US 5,488,524).

With respect to claim 1, Cunningham teaches a slider (108/201) being fixated on a slider arm (107) of a hard disk drive (100) and having a burnished surface (601) in a substantially parallel orientation to an opposing hard disk surface (102) (as shown in FIG. 6, for instance). As claim 1 is directed to a "slider", per se, the method limitation appearing in lines 3-5 of claim 1 can only be accorded weight to the extent that it affects the structure of the completed slider. Note that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process [i.e., "defined by burnishing said slider on said opposing hard disk surface using a burnishing fluid of He or Ne", for instance], and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior product was made by a different process", *In re Thorpe, et al.*, 227 USPQ 964 (CAFC 1985). Furthermore, note that a "[p]roduct-by-process claim,

although reciting subject matter of claim in terms of how it is made [i.e., "defined by burnishing said slider on said opposing hard disk surface using a burnishing fluid of He or Ne", for instance], is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations", *In re Hirao and Sato*, 190 USPQ 685 (CCPA 1976).

With respect to claim 32, Cunningham teaches a hard disk drive (100) having a slider (108/201) being fixated on a slider arm (107) of the hard disk drive, the slider having a burnished surface (601) in a substantially parallel orientation to an opposing hard disk surface (102) (as shown in FIG. 6, for instance). As claim 32 is directed to a "hard disk drive", per se, the method limitation appearing in lines 3-5 of claim 32 can only be accorded weight to the extent that it affects the structure of the completed hard disk drive. Note that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process [i.e., "burnished by an opposing hard disk surface in a substantially parallel orientation to said opposing hard disk surface using a burnishing fluid of He or Ne", for instance], and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior product was made by a different process." See *In re Thorpe, et al.*, supra. Furthermore, note that a "[p]roduct-by-process claim, although reciting subject matter of claim in terms of how it is made [i.e., "burnished by an opposing hard disk surface in a substantially parallel orientation to said opposing hard disk surface using a burnishing fluid of He or

Ne", for instance], is still product claim; it is patentability of product claimed and not recited process steps that must be established, in spite of fact that claim may recite only process limitations." See *In re Hirao and Sato*, supra.

Response to Arguments

7. Applicant's arguments filed 26 May 2004 have been fully considered but they are not persuasive.

The applicant argues that Cunningham does not teach "burnishing using a gaseous burnishing fluid of He or Ne." This argument, however, is not found to be persuasive for the following: As claims 1 and 32 are directed to a "slider" or a "hard disk drive", per se, the method limitations appearing in lines 3-5 of claims 1 and 32 can only be accorded weight to the extent that they affect the structure of the completed slider or hard disk drive. Note that "[d]etermination of patentability in 'product-by-process' claims is based on product itself, even though such claims are limited and defined by process [i.e., "burnishing using a gaseous burnishing fluid of He or Ne", for instance], and thus product in such claim is unpatentable if it is the same as, or obvious form, product of prior art, even if prior product was made by a different process." See *In re Thorpe, et al.*, supra. Furthermore, note that a "[p]roduct-by-process claim, although reciting subject matter of claim in terms of how it is made [i.e., "burnishing using a gaseous burnishing fluid of He or Ne", for instance], is still product claim; it is patentability of product claimed and not recited process steps that must be established, in

spite of fact that claim may recite only process limitations." See *In re Hirao and Sato*, supra.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

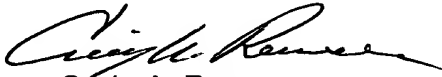
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (703) 308-0559. The examiner can normally be reached on Tuesday-Friday 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The

fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Craig A. Renner
Primary Examiner
Art Unit 2652

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